

## **REMARKS**

### **I. Introduction**

Claims 7 to 12 are pending in the present application. In view of the foregoing following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

### **II. Rejection of Claims 7 to 12 Under 35 U.S.C. § 101**

Claims 7 to 12 were rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. It is respectfully submitted that these claims are directed to statutory subject matter for at least the following reasons.

Claim 7 relates to a method for checking a bore hole and recites that the method includes, inter alia, shaping the bore hole in a workpiece by laser pulses that cause melting of a bore wall. Shaping of a bore hole in a workpiece by laser pulses that cause melting of a bore wall constitutes sufficient transformation under the “machine or transformation” test of In re Bilski, 88 U.S.P.Q.2d 1385 (Fed. Cir. 2008), i.e., transformation or reduction of a particular article into a different state or thing.

In view of all of the foregoing, withdrawal of the rejection is respectfully requested.

### **III. Rejection of Claims 7, 8 and 12 Under 35 U.S.C. § 102(b)**

Claims 7, 8 and 12 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,166,891 (“Reiter et al.”). It is respectfully submitted that Reiter et al. does not anticipate these claims for at least the following reasons.

Reiter et al. does not disclose, or even suggest, the features of claim 7 that a method for checking a bore hole includes comparing characteristic signals received within a characteristic time interval following a laser pulse to setpoint values, and that the characteristic time interval begins at an earliest as soon as at least a thin skin of a bore wall has solidified after melting by a preceding laser pulse and ending at a latest as soon as a new laser pulse occurs. Reiter et al. describes an apparatus and method for determining size accuracy of bores formed by laser pulses. As is apparent from column 3, lines 4 to 14 and Figure 1, the apparatus of Reiter et al. includes a laser generator (1), which generates a laser beam (2) that is reflected by mirrors (3, 4) through a collimating lens (5) and onto a workpiece (6).

The laser generator (1) emits laser pulses, which produce a bore in the workpiece (6). In addition, mirror (4) is semi-transparent, so that light reflected from the workpiece (6) can pass through the mirror (4) and arrive at optical recording instrument (21). Furthermore, as indicated in column 1, lines 36 to 44 of Reiter et al., the optical recording instrument (21) may produce a halftone image of a laser pulse on the workpiece (6) and determine, from this image, the size of the bore produced by the laser pulses and the compliance of the size with tolerance values established for the size. Moreover, as indicated on page 2, paragraph 4 of the Office Action, claim 5 of Reiter et al. provides that a half tone mosaic image of a bore may be produced between successive laser pulses. However **Reiter et al. nowhere indicates that the time period, during which the half tone images are produced, and which the Office Action considers to constitute a characteristic time interval, begins at an earliest as soon as at least a thin skin of the bore wall has solidified after a preceding laser pulse and ends at a latest as soon as a new laser pulse occurs. Reiter et al. merely indicates that the images may be formed between the laser pulses and does not indicate that the image is not formed until a thin skin of the bore wall has solidified.**

Accordingly, it is respectfully submitted that Reiter et al. does not anticipate claim 7 for at least these reasons.

As for claims 8 and 12, which depend from claim 7 and therefore include all of the features of claim 7, it is respectfully submitted that Reiter et al. does not anticipate these dependent claims unpatentable for at least the reasons set forth above.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

#### **IV. Rejection of Claim 9 Under 35 U.S.C. § 103(a)**

Claim 9 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Reiter et al. and Kleinhuber. It is respectfully submitted that the combination of Reiter et al. and Kleinhuber does not render this claim unpatentable for at least the following reasons.

As an initial matter, an English-language translation of Kleinhuber has not been provided by the Office, as required pursuant to M.P.E.P. § 706.02(II) ("If the document is in a language other than English and the examiner seeks to rely on that

document, a translation **must** be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection.” (emphasis added)).

Claim 9 depends from claim 7 and therefore includes all of the features included in claim 7. As mentioned above, Reiter et al. does not disclose all of the features included in claim 7, from which claim 9 depends. Kleinhuber is not relied upon for disclosing or suggesting the features of claim 7 not disclosed by Reiter et al. Accordingly, it is respectfully submitted that the combination of Reiter et al. and Kleinhuber does not render unpatentable claim 9, which depends from claim 7.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**V. Conclusion**

In light of the foregoing, Applicants respectfully submit that all pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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